



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,692	02/08/2002	Stefan Bonig	DT-6068	2080

30377 7590 08/12/2003

DAVID TOREN, ESQ.
SIDLEY, AUSTIN, BROWN & WOOD, LLP
787 SEVENTH AVENUE
NEW YORK, NY 10019-6018

EXAMINER

LOPEZ, FRANK D

ART UNIT PAPER NUMBER

3745

DATE MAILED: 08/12/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,692

Applicant(s)

BONIG ET AL.

Examiner

F. Daniel Lopez

Art Unit

3745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the braking element being a roller, a cylinder or a plate (claim 3), that the braking element is an elastic element (claim 6), and that the recess is either elastic or resilient (claim 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claim 9 is and are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9 line1 "said means" is confusing, since there is no "means" in claim 1. Suggest that claim 9 depend from claim 4, with —means for biasing—replacing "means", since claim 4 line 2 has "means for biasing".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 8 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Termet.

Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Termet. It would appear that the braking element (15) needs to be somewhat elastic, to cushion the movement of the piston, without wearing out either the braking element or the part of the piston contacting the

Art Unit: 3745

braking element. If not, it would have been obvious at the time the invention was made to one having ordinary skill in the art to make the braking element of Termet to be somewhat elastic, to cushion the movement of the piston, without wearing out either the braking element or the part of the piston contacting the braking element.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 4, 5, 7 and 9 and are rejected under 35 U.S.C. § 103 as being unpatentable over Termet in view of Ehmig et al. Termet discloses a setting tool comprising a piston (11) in an axially extending piston guide (5) and having a cylindrical section (13) close to a leading end, and a conical shaped surface (26) extending from the cylindrical surface, toward a trailing end; the conical surface being inclined inwardly towards the trailing end; a plate type (two semi-annular elements) braking element (15) mounted in a recess (20) of the guide in pressure contact with the cylindrical section, when the piston is in a ready to fire position, and the pressure contact reduces as the piston moves toward a leading end of the guide and the braking element is adjacent the conical surface; but does not disclose that there is a means in the recess biasing the braking element toward the piston, with the biasing means being an axially expending compression spring; wherein the recess has a base spaced radially outwardly from the piston and extending generally in an axial direction, and having an incline outward toward the trailing end of the guide, with the biasing means biasing the braking element

toward the leading end of the piston toward a wall of the recess perpendicular to the axis; or that the recess is either elastic or resilient.

Ehmig et al teaches, for a setting tool comprising a piston (11) in an axially extending piston guide (5) and having a braking element (including 17) mounted in a recess (16, and formed by 18) of the guide in pressure contact with a cylindrical section of the piston; that there is a means in the recess biasing the braking element toward the piston, with the biasing means being an axially expending compression spring (22); wherein the recess has a base spaced radially outwardly from the piston and extending generally in an axial direction, and having an incline (formed by 18a) outward toward the trailing end of the guide, with the biasing means biasing the braking element toward the leading end of the piston toward a wall (16) of the recess perpendicular to the axis; and that the recess is elastic and resilient (18, e.g. column 3 line 46).

Since the braking element of Termet and Ehmig et al are functionally equivalent in the piston art; it would have been obvious at the time the invention was made to one having ordinary skill in the art to replace the braking element of Termet with a braking element including a means in the recess biasing the braking element toward the piston, with the biasing means being an axially expending compression spring; wherein the recess has a base spaced radially outwardly from the piston and extending generally in an axial direction, and having an incline outward toward the trailing end of the guide, with the biasing means biasing the braking element toward the leading end of the piston toward a wall of the recess perpendicular to the axis; and that the recess is elastic and resilient, as taught by Ehmig et al, as a matter of engineering expediency.

Claims 4 and 6 are rejected under 35 U.S.C. § 103 as being unpatentable over Termet in view of Kindle et al. Termet discloses all of the elements of claims 4 and 6, as discussed in the rejection above; but does not disclose that there is a means in the recess biasing the braking element toward the piston; or that the braking element is an elastic element.

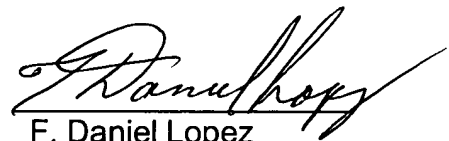
Kindle et al teaches, for a braking element interacting with an inclined portion of a piston of a setting tool; that the braking element includes a first set of elements (7) surrounded by a biasing ring (8).

Since the braking elements of Termet and Kindle et al are functionally equivalent in the piston art, it would have been obvious at the time the invention was made to one having ordinary skill in the art to replace the braking element of Termet with a braking element which includes a first set of elements surrounded by a biasing ring, as taught by Kindle et al, as a matter of engineering expediency.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is (703) 308-0008. The examiner can normally be reached on Monday-Thursday from 6:30 AM -4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on (703) 308-1044. The fax number for this group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.



F. Daniel Lopez
Primary Examiner
Art Unit 3745
August 7, 2003